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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/534,814
Filing Date: March 22, 2000
Appellant(s): GATES, DUANE CHARLES

Mr. Allen M. Lowe
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5-28-2008 appealing from the Office action mailed 12-31-2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 39-58 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

In claim 39 the new matter is listed on lines 7-13 and comprises describing the coil as having interior, intermediate and peripheral portions and also describing different magnetic fluxes for these different coil portions. Note that the original disclosure and claims are silent as to any discussion of magnetic flux. These same limitations are likewise found in claim 45 on lines 10-16, in claim 51 on lines 10-17 and claim 54 on lines 8-15. In claims 40, 46-50 new matter is disclosed as the new limitations setting forth that the interior coil comprises plural radially and circumferentially extending turns, with the intermediate portion not including a complete turn. Note that the original disclosure is drawn to a coil having a first and a second segment in series, and not the three segments now claimed. In claims 51 and 56 the new matter listed respectively in lines 15 and 16 and in lines 14 and 15 comprises the term, "the lead having at least a portion that is straight". Claims 40, 46, 51 and 54 set forth the new matter comprising, "(a) does not include a complete turn, 9b) is substantially less than a complete turn, and (c) includes a lead connected to ends of the

turns of the interior and exterior portions." No mention is made of this new matter in the original patent and disclosure. Applicant is required to point out specifically , where the original disclosure mentions the new matter limitations set forth above.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 39-58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new matter comprises inclusion of a coil comprised of three segments, an interior portion, an intermediate portion and a peripheral portion. The original specification described only a coil having two segments in series. The new claims set forth language describing a variation of magnetic flux relative to the coil segments. However, the original disclosure makes no mention of the term magnetic flux, and only mentions variation of coil current to effect a plasma having uniform plasma characteristics. Claims 40, 46, 51 and 54 contain the term, "does not include a complete turn", in reference to the intermediate portion of the coil description. The original disclosure makes no reference to this limitation, and only mentions the coil as having , "at least one arcuate portion", see column 3 line 57, and see claim 8 defining, ' and an arcuate conductor having at least one turn". No mention is made of

the term , "complete turn". The complete turn would indicate a 'coil" portion, and not a connector portion. No mention is made of the terms in claims 40,46,51 and 54, which sets forth the configurations of 9a), (b) and (c) in the previous paragraph, defining use of less than a complete turn and defining a straight portion of the intermediate coil portion, (also new matter).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 39,45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bignell. The amended claims define a work holder, not taught in Bignell. It is considered routine and obvious to use a work support, depending on the nature of the work processes. Bignell is silent as to the support since gas is heated. Note column 4 , lines 41-51, which denote a coil magnetic field intensity which is greater at the coil ends than the coil intermediate portion.

(10) Response to Argument

Appellant's remarks on pages 1—11 in the instant arguments advance that ,
"The examiner in the present case has not given any faith and credit to the position of the "Examiner who handled the Holland et al application". The instant Examiner

disagrees. The instant application is a reissue application and the present Examiner has determined that the present disclosure and the present claims contain new matter, not permissible in the instant application. Full faith and credit is given to the Examiner in the designated application, but the duty of the present Examiner lies with the present application and this duty is directed to the presence of new matter entered within a reissue application , and these instant claims are treated accordingly.

With respect to the new matter rejection, discussed on pages 12-16 in the Brief filed, the arguments set forth below discuss the same.

Claims 39-58 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

In claim 39 the new matter is listed on lines 7-13 and comprises describing the coil as having interior, intermediate and peripheral portions and also describing different magnetic fluxes for these different coil portions. Note that the original disclosure and claims are silent as to any discussion of magnetic flux. These same limitations are likewise found in claim 45 on lines 10-16, in claim 51 on lines 10-17 and claim 54 on lines 8-15. In claims 40,46-50 new matter is disclosed as the new limitations setting forth that the interior coil comprises plural radially and circumferentially extending turns, with the intermediate portion not including a complete turn. Note that the original disclosure is drawn to a coil having a first and a second

segment in series, and not the three segments now claimed. In claims 51 and 56 the new matter listed respectively in lines 15 and 16 and in lines 14 and 15 comprises the term, "the lead having at least a portion that is straight". Claims 40,46,51 and 54 set forth the new matter comprising, "(a) does not include a complete turn, 9b) is substantially less than a complete turn, and (c) includes a lead connected to ends of the turns of the interior and exterior portions." No mention is made of this new matter in the original patent and disclosure. Applicant is required to point out specifically, where the original disclosure mentions the new matter limitations set forth above.

Turning to the original disclosure, no mention is made of all of intermediate, interior and peripheral portions of the coil. No mention is made of variation of the magnetic flux from different portions of the coils. Column 2 line 60 in the specification of the patent under reissue only defines, "to improve the special uniformity of RF power coupling". The specification, as discussed above and during the prosecution of the instant application, is silent as to any variation of the magnetic flux due to the orientation of the inner, intermediate and outer sections of the coil. The Examiner of record has requested the Applicant to point out in the original specification, just where basis relies for the amendments during reissue. Applicant has not replied to this request, simply because there is no antecedent basis for this terminology.

Appellant's argue on page 12 in the brief that, "can be read on the disclosure of the present application", and on page 13 in the brief that "this requirement is inherently provided by Appellant's structure". This argument is without patentable merit since the magnetic flux density is dependent on multiple parameters, such as current variation

and spacing of the coil turns relative to one another. The original specification is silent as to any magnetic flux variation, any relative spacing of the coil portions and any current variation in the individual segments. Applicant's, in the original patent merely discuss individual coil segments connected together.

For instance claim 30 defines, "a coil including interior, intermediate and peripheral portions, the interior, intermediate and peripheral portions having turns connected to each other and arranged so that the magnetic flux density coupled to the plasma by each of the interior, intermediate and peripheral portions exceeds the magnetic flux density coupled to the plasma by the intermediate coil portion".

The original claimed subject matter is devoid of these limitations. In addition, as set forth above, the variation of the magnetic flux is dependent on multiple parameters such as coil spacing's and current variation in the individual coil segments, relative to one another. The coil segments described are series connected segments having common current, and no spacing is mentioned in the original disclosure.

Appellants are seeking patent protection for claimed subject matter having no antecedent basis in the original patent. Entering new matter into a reissue application to enhance the scope of the original claimed subject matter, is not permissible and the new matter rejection stands and should be sustained.

There is absolutely no mention of the term "magnetic flux", in the original patent.

With respect to Appellant's remarks on pages 16-17 in the brief, discussing Dr. Patrick's Declaration, this declaration has been addressed in the final rejection on pages 4-5. As Appellant's correctly notes on page 16 in the brief, last paragraph, "The declaration of Dr. Patrick clearly indicates how the coil has individual portions, as set forth in the independent claims". However no mention is made in the claimed subject matter of the spacing of the coils, the current through the coils, the diameter of the coils and the variation of magnetic flux through the coil portions. All of the above parameters are critical to the variation of magnetic flux from one portion to another coil portion. The variation of magnetic flux is not inherent, minus discussion of these parameters. Once again, Appellant's and Dr. Patrick are required to point out just where the antecedent basis for the term "magnetic flux" resides in the original patent. The board of Appeals should note that the variation of magnetic flux is critical to the instant claimed subject matter and has no basis in the original patent filed. To just state that this feature is "inherent" carries no persuasive weight in the instant appeal. This feature is the crux of the present invention.

With respect to the art rejection in view of Bignell, applicant's attention is directed to figure 2b that teaches tube 12 that holds the work gas, with an inductive coil 11 that has top coil spacing and bottom coil spacing, differing from the intermediate coil spacing. See column 4, lines 41-51 for teaching magnetic flux variation in the coil portions. Since the work is held within work holder 12, the claimed subject matter is met. Note that the magnetic flux is less in the center of tube 12, due to the reduced coil

spacing. The claims are silent as to the type of work processed, solid or gas, and the claims are also silent as to any specifics of the work processed. One of ordinary skill in the art would be motivated by such teaching to pick and choose an appropriate work holder dependent on the end use of the device, yet undisclosed.

Conclusion

For the reasons set forth supra, the instant application is seeking patentable subject matter based on new matter added to the reissue filing. The patent to Bignell renders the claimed subject matter obvious for the above reasons. The current final rejection of the claims is proper and should be sustained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Mark H Paschall/

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